

Notice of Allowability	Application No.	Applicant(s)	
	10/791,278	SLUSHER ET AL.	
	Examiner	Art Unit	
	Susannah Chung	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to RCE filed 1/18/2006.
2. ☒ The allowed claim(s) is/are 1,3,4,18,39,40 and 42.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>092105</u> . |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>1/18/2006</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

Claims 1-42 are pending in the instant application.

Information Disclosure Statement

The information disclosure statement (IDS), filed on 01/18/2006 has been considered. Please refer to Applicant's copy of the 1449 submitted herewith.

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Attorney Suet Chong on 10/03/2005.

The application (Claims submitted on 03/03/2004) has been amended as follows:

Delete claims 2, 5-17, 19-38, and 41.

In claim 1, line 1, **delete** “, II or III” after the word formula I.

In claim 1, line 2, **delete** “II” and “III” and the accompanying figures.

In claim 1, line 9, **delete** “-O-, -S-,” after the word is.

In claim 1, line 9, **delete** “or –NR3-“ after the word –CR3R4.

In claim 1, line 11, **delete** “1,” after the word is.

In claim 1, line 11, **delete** “, 3, or 4” after the word 2.

Delete claim 18 and **insert** “A method of treating peripheral neuropathy, comprising administering to a mammal in need of such inhibition, treatment or effect, an effective amount of a compound of formula I of claim 1”.

In claim 39, line 2, **delete** “, II or III” after the word formula I.

In claim 39, line 3, **delete** “II” and “III” and the accompanying figures.

In claim 39, line 10, **delete** “-O-, -S-,” after the word is.

In claim 39, line 10, **delete** “or -NR3-“ after the word -CR3R4.

In claim 39, line 12, **delete** “1,” after the word is.

In claim 39, line 12, **delete** “, 3, or 4” after the word 2.

Reasons for Allowance

The present invention is directed to thiolactones and their methods of use for the treatment of a neurological disorder that is diabetic neuropathy. The closet prior art of record, U.S. Patent Num. 6,812,364 ('364 Patent), teaches substituted tetrahydro-2H-thiopyran compounds wherein the group corresponding to X is Ar instead of an alkyl chain like in the instant application. The instant compounds of Claims 40 and 42 are patentable because the prior art does not teach that X can be an alkyl chain.

The method of treating peripheral neuropathy is supported in the specification in paragraph 136, page 28, line 19 and page 13, line 3; page 14, line 6; page 16, line 4, etc... In addition, the state of the art supports the use of thiophene derivatives in the treatment of neuropathic pain, in particular peripheral neuropathy. See Expert Opin. Emerging Drugs (2005) 10(1): 95-108.

Art Unit: 1626

Telephone Inquiry

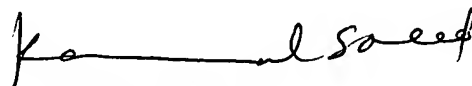
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Chung whose telephone number is (571) 272-6098.

The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susannah Chung
Patent Examiner, AU 1626
03/10/2006



KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER